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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/031,162

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Nikolai Grigorievich Lyapko

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EXAMINER

SEVERSON, RYAN J

ART UNIT

PAPER NUMBER

3731

NOTIFICATION DATE

DELIVERY MODE

02/04/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

iw@wabpc.com  
pb@wabpc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/031,162	<b>Applicant(s)</b> LYAPKO, NIKOLAI GRIGORIEVICH	
	<b>Examiner</b> Ryan J. Severson	<b>Art Unit</b> 3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because it is too long. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

2. Claim 26 is objected to because of the following informalities: It appears applicant is claiming a part of the body (at the 2nd to last line, "contacting with an user's epidermis"). Examiner suggests amending this limitation to state "configured to" or "adapted to" contact a user's epidermis to make clear that the epidermis is not being claimed as part of the invention. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14 and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 26 recites the limitation "each needle is surrounded by needles." It is unclear how every needle could be surrounded by other needles. This implies that there is no edge on the base member, because if there was an edge, the needles

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immediately adjacent the edge would not be "surrounded by needles" as claimed. This is deemed impossible because the dependent claims require the base to be planar, and therefore it is not possible for the base member to be without an edge.

6. Claim 26 recites the limitation "the surface" in line 16. There is insufficient antecedent basis for this limitation in the claim.

7. Claims 14, 24 and 25 each recite structure such as "a sharpened portion", "a head portion", and "first and second coating materials". These structures already are introduced into independent claim 26, and therefore it is unclear if applicant is claimed additional sharpened portions, etc. or if those structures referred to in the dependent claims are the same as the ones already recited in the independent claim. Examiner encourages applicant to thoroughly review each dependent claim to ensure that no structures are claimed multiple times, as is the case with the pending set of claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (5,676,684) in view of Gabrusenok (SU 1264942).** Choi discloses an elastic base member (15) and needles (see column 5, line 14) fixed therein, each of the needles comprising a rod member (core), a sharpened portion and a head (the portion of the needle adjacent to base member 15). Choi also discloses the various needles in the

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same treatment device can be different materials (see column 5, lines 28-32). Choi does not disclose the needles as being partially coated with a coating. However, Gabrusenok teaches that acupuncture needles should be partially coated with coatings of a material which is different than the needle material in order to obtain the advantage of creating electrochemical potentials (see abstract of Gabrusenok). It would have been obvious to partially coat the Choi needles with a material which is different than the material of the needles so that it too would have this advantage. Further, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Therefore, one of ordinary skill in the art would have recognized that choosing various materials for the needles would be obvious.

10. **Claims 14, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (5,676,684) in view of Gabrusenok (SU 1264942) as applied to claim 26 above, and further in view of Wybrants (2,441,682).** The combination of Choi and Gabrusenok fails to disclose the needles having enlarged head portions lying in a single plane. Attention is drawn to Wybrants, who teaches elongated treatment elements (19, analogous to needles) having head portions (see figure 3) in a single plane to retain the treatment elements on the base member of the applicator. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included heads arranged in a planar fashion on the needles of Choi in the manner taught by Wybrants to help retain the needles in the base member.

***Response to Arguments***

11. Applicant's arguments filed 10/7/2009 have been fully considered but they are not persuasive.

12. Examiner notes that new independent claim 26 is actually more broad than the previous independent claims because it does not require the heads of the needles to be arranged in a single flat plane.

13. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

14. Applicant further argues that modifying the Choi needles to include various materials and coating as taught by Gabrusenok would render the Choi device inoperable and would embody great technological difficulties. However, applicant provides no *evidence* to support such assertions, and Examiner thereby disagrees.

15. Examiner further notes that there does *not* need to be an explicit rationale/motivation in prior art references to make them properly combinable under 35 USC 103. Regardless, Gabrusenok explicitly teaches that making needles with

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coatings to create electrochemical potentials is desirable to reduce the time taken for treatment by raising the accuracy of localization of said treatment.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J. Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 8:30-5:00.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan J. Severson/  
Examiner, Art Unit 3731  
1/29/10

/Anhtuan T. Nguyen/  
Supervisory Patent Examiner, Art Unit 3731  
1/31/10